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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,124	04/20/2007	Klaus Kulper	101769-370 KGB	4140
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Briscoe, Kurt G. Norris McLaughlin & Marcus, PA 875 Third Avenue, 8th Floor New York, NY 10022			HUANG, CHENG YUAN	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,124

Applicant(s)

KULPER ET AL.

Examiner

CHENG HUANG

Art Unit

1787

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 March 2011 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 3-8, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terry et al. (U.S. Patent Application Publication No. 2005/0180704).

5. Regarding claim 1, Terry et al. teaches a tape for bandaging cable harnesses (See Abstract), comprising a backing with a first outer layer A inherently having a first side (support 16, paragraph [0032]), wherein the first side of the first outer layer A connected to a separate layer C (open layer 10', paragraph [0032]) over an entire area of the first side of the first outer layer A (Fig. 4), the outer first layer A is composed of a scrim or woven fabric (paragraph [0039]), and the layer C being composed of a textile having an open but stable three-dimensional structure (paragraphs [0033] and [0034]).
6. Terry et al. does not explicitly teach wherein the layer C is firmly connected on an open side to a second separate outer layer B over the entire area of a first side of the outer layer B, wherein the outer layer B is composed of a velour, scrim, woven fabric or formed-loop knit.
7. However, Terry et al. teaches a support layer composed of woven fabric or scrim (paragraph [0039]). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a support layer on open layer 10' for added protection or mechanical strength. The duplication of parts is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. Providing a second support would have achieved expected results such as protection or mechanical strength. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. MPEP 2144.04 (VI) B. *In re Harza*, 124 USPQ 378, 380 (CCPA 1960). The resulting structure of Terry et al. teaches wherein the layer C is firmly connected on an open side to the second separate outer layer B over the entire area of a first side of the outer layer B.
8. While there is no disclosure that the tape is abrasion-resistant and noise-suppressing as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body

of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

9. It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. abrasion-resistant and noise-suppressing, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art invention and further that the prior art structure which is a tape identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

10. Regarding claim 3, given that Terry et al. teaches wherein first outer layer A comprises polyester (paragraph [0033]) and layer C comprises polyester or propylene (paragraph [0041]) which are materials identical to those of the presently claimed invention, it is expected that the backing of Terry et al. inherently possesses the abrasion resistance of the presently claimed invention.

11. Regarding claim 4, Terry et al. teaches wherein the layer C is a three-dimensional nonwoven structure (paragraphs [0033] and [0034]).

12. Regarding claim 5, Terry et al. teaches wherein the layer C has a thickness of 0.1 to 6 mm (paragraph [0033]).
13. Regarding claim 6, the resulting structure of Terry et al. teaches further comprising a mechanical bond formation joining, without adhesive, the separate layers A, B and C to form an assembly (paragraph [0049]).
14. Regarding claim 7, the resulting structure of Terry et al. teaches wherein the layers A, B, and C comprise wear-resistant polymers (paragraphs [0033] and [0041]) given that the presently claimed invention discloses that wear-resistant polymers include polyesters and polyolefins (paragraph [0048]).
15. Regarding claim 8, Terry et al. teaches wherein the backing is coated at least on one side with a self-adhesive layer (adhesive 22, paragraph [0045]), wherein the layer C intrinsically has a thickness defined between a first side and a second side opposite to the first side.
16. Terry et al. does not explicitly teach wherein the entire thickness of layer C is located between the first side of the layer A and the self-adhesive layer.
17. However, Terry et al. teaches a self-adhesive layer (adhesive 22, paragraph [0045]). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an adhesive layer on open layer 10' for added adhesion. The duplication of parts is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. Providing a second adhesive would have achieved expected results such as adhesion. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. MPEP 2144.04 (VI) B. *In re Harza*, 124 USPQ 378, 380 (CCPA 1960). The resulting

structure of Terry et al. teaches wherein the entire thickness of layer C is located between the first side of the layer A and the self-adhesive layer.

18. Regarding claim 13, the resulting structure of Terry et al. teaches further comprising a first laminating adhesive joining the separate layers A and C to form an assembly (adhesive 22, paragraph [0045]).

19. Terry et al. is silent as to a second laminating adhesive joining the separate layers C and B.

20. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a second laminating adhesive between separate layers B and C in order to better adhere the layers.

21. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a laminating adhesive between separate layers B and C for increased adhesion. The duplication of parts is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. Providing a second adhesive would have achieved expected results such as additional adhesion. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. MPEP 2144.04 (VI) B. *In re Harza*, 124 USPQ 378, 380 (CCPA 1960).

22. Furthermore, regarding claim 13, Applicants admit in paragraph [0030] of the US-PG Pub, that it is well known in the art to use laminating adhesives in order to create a stable, potentially load-bearing assembly. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include laminating adhesives in between separate layers A and C and separate layers C and B to create a stable, potentially load-bearing assembly.

23. Regarding claim 14, the resulting structure of Terry et al. teaches wherein the self-adhesive layer is made of an acrylate adhesive (paragraph [0046]).

24. Claims 1, 3-5, 7-8, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulper (DE 10039982) in view of Blackmore et al. (5,695,373). It is noted that the disclosures of Kulper are based on (U.S. Patent Application Publication No. 2004/0082243) which is an English equivalent of the reference.

25. Regarding claim 1, Kulper teaches an abrasion-resistant and noise-suppressing tape for bandaging cable harnesses (See abstract, paragraph [0115]), comprising a backing with a first outer layer A inherently having a first side (intermediate, paragraph [0069]), wherein the first intrinsically side of the first outer layer A is connected to a separate layer C (backing, paragraph [0064]) over an entire area of the first side of the first outer layer A (paragraph [0069]), wherein the first outer layer A is composed of a formed-loop knit (paragraph [0071]), and the layer C being composed of a textile intrinsically having an open but stable three-dimensional structure (Multiknit, paragraphs [0064]-[0068]).

26. Kulper fails to teach a separate second outer layer B.

27. However, Blackmore et al. teaches a composite comprising wherein a layer C is firmly connected on an open side to a separate second outer layer B over an entire area of a first side of the second outer layer B (col. 4, lines 42-43 and 54-60), wherein the second outer layer B is composed of a scrim (col. 4, lines 47-48).

28. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a separate second outer layer B firmly connected to layer C of Kulper to provide more flexibility (Blackmore et al., col. 4, lines 34-35).

29. Regarding the limitation that the tape is abrasion-resistant and noise-suppressing, Applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

30. It is the examiner’s position that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the purpose or intended use, i.e. abrasion-resistant and noise-suppressing, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art invention and further that the prior art structure which is a tape identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

31. Regarding claims 3 and 7, Kulper as modified by Blackmore et al. teaches wherein the layers B and C comprise wear-resistant polymers (Kulper, polyester, paragraph [0081]; Blackmore et al., polyester, col. 4, lines 42-45).
32. Kulper fails to teach wherein the layer A comprises wear-resistant polymer.
33. However, Blackmore et al. wherein a layer comprises wear-resistant polymer (polyester, col. 4, lines 42-45).
34. It would have been obvious to one of ordinary skill in the art at the time of the invention to include polyester in layer of Kulper to allow greater elongation and tear resistance (Blackmore et al., col. 4, lines 45-47).
35. Given that Kulper as modified by Blackmore et al. teaches wherein first outer layer A comprises polyester (Blackmore et al., col. 4, lines 42-45) and layer C comprises polyester (Kulper, paragraph [0081]) which are materials identical to those of the presently claimed invention, it is expected that the backing of Kulper as modified by Blackmore et al. inherently possesses the abrasion resistance of the presently claimed invention.
36. Regarding claim 4, Kulper teaches wherein the layer C is a nonwoven structure (paragraphs [0064]-[0065]) that is intrinsically three-dimensional.
37. Regarding claim 5, Kulper teaches wherein the layer C has a thickness of 0.4 mm (paragraph [0120]) which falls within the claimed range of 0.2 to 3 mm.
38. Regarding claim 8, Kulper as modified by Blackmore et al. teaches wherein the backing is coated at least on one side with a self-adhesive layer (Kulper, paragraph [0083]), wherein the layer C has a thickness intrinsically defined between a first side and a second side opposite to the

first side, wherein the entire thickness of layer C is intrinsically located between the first side of the first outer layer A and the self-adhesive layer.

39. Regarding claim 13, Kulper teaches further comprising a first laminating adhesive joining the separate layers A and C (Kulper, paragraph [0083]).

40. Kulper fails to teach a second laminating adhesive joining the separate layers C and B to form an assembly.

41. However, Blackmore et al. teaches an adhesive joining the separate layers C and B to form an assembly (col. 4, lines 58-59).

42. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a second laminating adhesive joining the separate layers C and B of Kulper as modified by Blackmore et al. in order to better adhere the layers together.

43. Furthermore, regarding claim 13, Applicants admit in paragraph [0030] of the US-PGPub, that it is well known in the art to use laminating adhesives in order to create a stable, potentially load-bearing assembly. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include laminating adhesives in between separate layers A and C and separate layers C and B to create a stable, potentially load-bearing assembly.

44. Regarding claim 14, Kulper as modified by Blackmore et al. teaches wherein the self-adhesive layer is made of a rubber or acrylate or silicone adhesive (Kulper, paragraph [0083]).

45. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kulper (DE 10039982) in view of Blackmore et al. (5,695,373), and further in view of Gladfelter et al. (U.S.

Patent No. 6,309,721). It is noted that the disclosures of Kulper are based on (U.S. Patent Application Publication No. 2004/0082243) which is an English equivalent of the reference.

46. Kulper as modified by Blackmore et al. is relied upon as disclosed above.

47. Kulper fails to teach further comprising a mechanical bond formation joining, without adhesive, the separate layers A, B and C to form an assembly.

48. However, Gladfelter et al. teaches a sleeve for noise-suppression (See Abstract) further comprising a mechanical bond formation joining, without adhesive, separate layers A, B and C to form an assembly (outer layer, support layer, inner layer, col. 3, lines 56-65).

49. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a mechanical bond formation joining, without adhesive, separate layers A, B and C of Kulper as modified by Blackmore et al. to produce an interlocked laminated three-layer product having high hoop strength and substantial flexibility (Gladfelter et al., col. 3, line 64-col. 4, line 2).

37 CFR 1.131 Affidavit

50. The affidavit filed 25 March 2011 under 37 CFR 1.131 has been considered but is ineffective to overcome Terry.

51. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of 02/17/2004. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means

themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

52. Applicant has submitted an exhibit in order to establish the conception of the present invention prior to the effective date of Terry. However, the documents provided by applicant do not provide clear and convincing evidence of such.

The present claims require an abrasion-resistant and noise-suppressing tape for bandaging cable harnesses, comprising a backing with a first outer layer A having a first side, wherein the first side of the first outer layer A is connected to a separate layer C over an entire area of the first side of the first outer layer A, wherein the layer C is firmly connected on an open side to a separate second outer layer B over an entire area of a first side of the second outer layer B, wherein the first outer layer A is composed of a velour, scrim, woven fabric or formed-loop knit, the second outer layer B is composed of a velour, scrim, woven fabric or formed-loop knit, and the layer C being composed of a textile having an open but stable three-dimensional structure.

The exhibits filed 25 March 2011 with the 1.131 declaration disclose an abrasion-resistant tape comprising a backing with a first outer layer A having a first side, wherein the first side of the first outer layer A is connected to a separate layer C over an entire area of the first side of the first outer layer A, wherein the layer C is connected on an open side to a separate second outer layer B over an entire area of a first side of the second outer layer B, wherein the first outer layer A is composed of a woven fabric, and the second outer layer B is composed of woven fabric, and the layer C being composed of a textile having an open but stable three-dimensional structure with the disclosure of layer C being composed of Multiknit. However,

there is no disclosure of a noise-suppressing tape, tape for bandaging cable harnesses, or wherein the layer C is “firmly” connected, as required in the present claims.

MPEP 2138.04 states that “conception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill.” Given that the documents do not disclose the limitations as recited above, it is the examiner’s position that the 1.131 declaration has not established conception of the present invention prior to the effective filing date of Terry.

For these reasons, the 1.131 declaration is ineffective in removing Terry as a valid reference.

53. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of (reference name).

For an explanation, see paragraph 52 above, which is incorporated here by reference.

Response to Arguments

54. Applicants’ arguments filed 25 March 2011 have been fully considered but they are not persuasive.

55. Applicants argue that Terry cannot be used as a reference against the present claims in light of the 1.131 affidavit which establishes a date of invention for the present invention which is prior to the earliest U.S. filing date of Terry. However, for the reasons described in

paragraphs 50-53 above, the 1.131 affidavit is ineffective in removing Terry as a reference, and thus, Terry remains as a relevant reference against the present claims.

56. Applicants argue that Terry qualifies as a reference under 102(e) and not under 102(b).

57. It is agreed that Terry is in fact applicable as prior art under 102(e).

Conclusion

58. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

59. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

60. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1787

May 5, 2011

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787